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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,657	10/27/2003	Tom Franklin	FRANKL03-02	4001

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EXAMINER	
HSU, RYAN	

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/694,657	FRANKLIN, TOM	
	Examiner	Art Unit	
	Ryan Hsu	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 October 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

The drawings filed on 10/27/2003 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftsperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claims 4-5, the phrase "according to the rankings of Poker" renders the claim indefinite because it is unclear what the limitations the claim is directed towards. It is common in the art to have many different types of rules while still encompassing the scope of the game of Poker. Additionally, the general statement towards the standard rankings of Poker in the claim is still contradictory to the specification. The current method calls for three separate hands and as stated in the specification only uses the standard ranking of poker for hands where "N" is equal to five cards. The specification states the use of special rankings for hands where "N" is less than five cards.

Claim Objections

Claims 1 and 5 are objected to because of the following informalities: the contain a reference tables that contain the limitation referring to "Hand 1", "Hand 2" and "Hand 3"

however there is no antecedent basis or definition of these terms in the claim itself. It is not known to determine whether Hand 1, Hand 2, or Hand 3 refer to a low ranked hand, a middle ranked hand or a higher ranked hand. *See MPEP 2173.05(e).* Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 are rejected on the ground of nonstatutory double patenting over claims 1-4 of U. S. Patent No. 6,155,568 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter,

as follows: Application 10/694657 is directed towards a poker game which assembles three hands and comprises a player to make a wager and form a low, middle, and high hand with N (where N can be any number) cards. Additionally, the current application calls for "the player and dealer assembling said low, middle and high hands" and to compare "the corresponding dealer and player low hands, middle hands, and high hands and if the at least two of the player's hands outrank the corresponding two dealers hands, issuing an award to the player". Regarding U.S. Patent 6,155,568; the claim 1 is directed towards a method of player a poker game using a 52 card deck of playing cards and a method comprising: "the player making a wager" and "dealing from the deck seven cards to form a player holding and to form a dealer holding, for each of said player and dealer hands assembling them into a two card low hand, a two card middle hand and a three card high hand". Furthermore, the patent calls for the "comparing the rankings of the player's high hand, middle hand and low hand to the dealer's high, middle and low hands and (1) if the at least two of the player's hands have a higher rankings than the corresponding dealer's hands, declaring the player hand the winner, (2) if two of more of the dealer's hands outrank or have a tie ranking with the corresponding the player's hands declaring the dealer hand the winner". The two claim limitations vary only by the limiting factor of N being 3,2, and 2 in the high, middle, and low hands, respectively, whereas the current application does not limit the value of N. However, the current limitations correspond to the basic methodology of the game itself and it would be obvious to one of ordinary skill in the art to modify the previous limitations to incorporate a different number of cards dealt to meet the limitations of the current application. Therefore the limitations disclose above in application 10/694657 and Patent 6,155,568 are not patentably distinct as the current application broadens

the scope of the previous claims but maintains the same methodology of the previous disclosed poker game. Therefore it would have been obvious that these two inventions are not patentably distinct but simply are different embodiments of the same invention.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marquez (US 5,294,128) and further in view of Feola (US 6,702,289 B1).

Regarding claim 1, Marquez teaches a method of playing a poker game by assembling at least three hands. Marquez's method of playing a card game comprises: the player making a wager and dealing cards to a player position and dealer position sufficient for each to form at least a low hand, a middle hand and a high hand or one card each where N = number of cards for each hand and hands have N cards (*see abstract*). Additionally, Marquez teaches that the low

hand must contain at least 1 card and the middle hand must be greater than or equal to the number of cards in the low hand and the high hand must contain a number greater than or equal to the number of cards in the middle hand (*see Fig. 3 and the related description thereof, col. 2: ln 5-35*). The examiner has equated the Marquez teaching of a low hand containing one card and the middle hand containing 2 cards and the high hand containing 3 cards as an equivalent. Furthermore, Marquez calls for comparing the corresponding dealer and player low hands, middle hands and high hands and if the at least two of the player's hands outrank the corresponding two dealers hands, issuing an award to the player (*see col. 3: ln 20-col. 4: ln 40*). However, Marquez is silent with regard to the player and dealer assembling the low, middle and high hands so that the middle hand outranks the low hand and the high hand outranks the middle hand. Although Marquez does teach that a desired ranking of the cards exists however not in a manner where the middle hand outranks the low hand and the high hand outranks the middle hand.

In a related gaming patent, Feola teaches a method of playing a Pai Gow Poker. Feola teaches that Pai Gow is a variation in the game of poker that comprises of two hands. A high hand and a low hand (*see col. 1: ln 26-56*). The high hand comprises of five cards and the low hand comprises of two-cards. The object of the game is to have the high hand and low hand outrank the dealer's respective high hand and low hands (*see Fig. 6 and the related description thereof*). Furthermore, Feola teaches where in Pai Gow Poker the five card hands outrank the two card hands in a hi-low type Poker game. One would be motivated to incorporate this type of rule into a method of playing a poker game because under the standard rankings found in a poker game one would potentially be able to make a higher-ranking hand with more cards then with a

hand with less cards (*ie: limited to top pair in two-card hand as opposed to a royal flush with a five-card hand*). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Feola with Marquez in order to create a three card poker game with a high, middle, and low card ranking.

Regarding claim 2, Marquez teaches a method of playing cards comprising dealing cards to the player and dealer in the form of low, middle and high hands. Where hand 1 comprises N number of cards where N greater than or equal to 1. Additionally, hand 2 comprises N number of cards where N is a number greater than the cards of hand 1 and hand 3 comprises of N cards where N is a number greater than or equal to the cards of Hand 2 (*see '1 card hand', '2 card hand', and '3-card hand' of Fig. 3 and the related description thereof*).

Regarding claim 3, Marquez teaches a method of playing cards comprising dealing six cards to the dealer and player and each forming a one card low hand, a two card middle hand and a three card high hand (*see col. 2: ln 60-67, '1 card hand', '2 card hand', and '3-card hand' of Fig. 1 and the related description thereof*).

Regarding claim 4, Marquez teaches a method comprising ranking the hands according to the ranking of Poker (*see col. 3: ln 20-col. 4: ln 25*).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marquez and Feola as applied to claims above, and further in view of Webb (US 6,443,455 B1).

Regarding claim 5, Marquez teaches the method of assembling a three-card poker game with a low, middle, and high hand as taught above. Feola teaches the methodology of ranking

the high, middle, and low hands in an order based upon the number of cards. However both are silent with regard to the implementation of a methodology into an electronic gaming device.

In a related gaming patent, Webb teaches a device for playing a poker game using a device for the player to input a wager, a display (*see display [30] of Fig. 2 and the related description thereof*), and a data processor (*see processor [34] of Fig. 2 and the related description thereof*) configured to randomly select from a data structure storing data representing a deck of playing cards, playing cards for each of a dealer hand and a player hand and to display at the display the cards of the player hand (*see player interface [32] of Fig. 2 and the related description thereof*). Furthermore, Webb teaches that the gaming machine is capable of prompting the user through the operation of the game. One would be motivated to incorporate a poker game into a game machine in order to increase the accessibility of the game without having to provide a table and a dealer in order to realize the methodology of the poker game. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Webb with the poker game taught by Marquez and Feola in order to create a poker game with three cards with an electronic game machine.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Breeding (US 5,288,081) – Method of Playing a Wagering Game.

Bridgeman et al. (US 5,224,706)-Gambling Game and Apparatus with Uneven Passive Banker.

Kadlic (US 6,146,271)- Multiple Play Pick One Poker.

Any inquiry concerning this communication or earlier communication from the examiner should be direct to Ryan Hsu whose telephone number is (571)-272-7148. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached at (571)-272-6788.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll-free).

RH

April 27, 2006

JOHN M. HOTALING, II
PRIMARY EXAMINER